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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Toshiaki KOUE et al. Group Art Unit: 2134

Application No.: 09/987,672 Examiner: D. JUNG

Filed: November 15, 2001 Docket No.: 111114

For: INTERNET FACSIMILE AND CONTROL METHOD THEREOF AND COMMUNICATION INSTRUCTION TERMINAL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A Notice of Appeal and Petition for Extension of Time is attached. Applicants respectfully request review of the Final Rejection mailed August 23, 2007 in view of the following remarks. Claims 1-17 are pending in this application. Claims 1-17 are rejected.

This review is requested specifically to address what Applicants believe is an improper construction regarding what Cisco (http://community.roxen.com/developers/idocs/rfc/rfc2305.html) and Windows 95, at http://www.microsoft.com/technet/archive/win95/rk27_fax.mspx?mfr=true (hereinafter "Windows 95") can reasonably be considered to have suggested with respect to the subject matter of the pending claims.

Independent claim 1 recites a control method of an Internet facsimile having at least the steps of receiving electronic mail containing an encrypted password relating to a control command for indicating a facsimile communication function; decrypting the encrypted password; and transferring an electronic mail document by facsimile following the control command using the decrypted password. The Office Action and the Advisory Action assert

that Cisco and Windows 95, individually, can reasonably be considered to teach these features. This conclusion is in error for at least the following reasons.

The Office Action, on page 4, asserts that Cisco, at section 5.3.2, teaches all of the features recited in claim 1. However, the Office Action misconstrues the positive teachings of section 5.3.2 of Cisco in attempting to reject claim 1. Cisco, at section 5.3.2, merely discloses message encryption and refers to examples such as PGP-MIME and S-MIME. Cisco further discloses that message encryption protocols, such as PGP-MIME and S-MIME, can be used to provide end-to-end encryption of the entire message text. Section 5.3.2 of Cisco does not disclose or suggest transferring an electronic mail document by facsimile following the control command using the decrypted password.

The Office Action, on page 6, asserts that Windows 95 discloses all of the features recited in claim 1. Windows 95 discloses defining a password to share a facsimile server (see the paragraph bridging pages 7 and 8). Windows 95 also discloses encrypting a facsimile with a private key/public key (see page 9). For example, Windows 95 discloses that when an electronic mail containing a password is sent using S/MIME, a destination would receive the "electronic mail containing the encrypted password" and decrypt the "encrypted password." However, even if a received electronic mail contains an encrypted password, Windows 95 does not disclose nor can it reasonably be considered to have suggested, any use for the decrypted password is used for. In this regard, Windows 95 cannot reasonably be considered to teach, or to have suggested, receiving electronic mail containing an encrypted password relating to a control command for indicating a facsimile communication function; and transferring an electronic mail document by facsimile following the control command using the decrypted password.

Independent claim 6 recites a determination section...for determining whether or not a password related to a control command for indicating a facsimile communication function is

encrypted and set in the electronic mail; a decryption section for decrypting the password if the determination section determines that the electronic mail has the encrypted password; and a communication control section for transferring the electronic mail by facsimile following the control command using the decrypted password. For the reasons discussed above with respect to Cisco and Windows 95, the analysis of the Office Action fails here as well.

Independent claim 11 recites an encryption section for encrypting a password related to a control command, wherein the control command is for indicating a facsimile communication function. Neither Cisco, nor Windows 95 can reasonably be considered to teach, or to have suggested these features.

In rejecting claim 11, the Office Action asserts that the term "control command" can be broadly interpreted. Specifically, the Office Action asserts that the control command includes a command to receive/decrypt a facsimile. Despite these assertions, the Office Action misconstrues the scope of claim 11. Claim 11, as noted above, recites among other features, a password related to a control command. Neither Cisco, nor Windows 95 disclose, nor can they reasonably be considered to have suggested, a password related to a control command. Cisco discloses only that message encryption protocols, such as PGP-MIME and S-MIME, can be used to provide end-to-end encryption of the entire message text. As noted above, Windows 95 discloses defining a password to share a facsimile server. Windows 95 also discloses encrypting a facsimile with a private key/public key (see page 9). However, Windows 95's Microsoft fax fails to disclose an encrypted password key that relates to the control command.

Independent claim 16 recites a communication control section for transferring the received electronic mail by facsimile over the telephone network only if the determination section determines that the transmission source is identified correctly. The Office Action

asserts that sections 5.2.1, 5.2.3 and 5.2.4 of Cisco teach the above-recited feature. This assertion is unreasonable for the following reasons.

Sections 5.2.1, 5.2.3 and 5.2.4 of Cisco do not relate to the transferring of the received electronic mail. Cisco, at section 1 and section 5.2.1, merely discloses that electronic mail messages should be provided with a method of preventing the disclosure of sensitive information. Cisco, at section 5.2.3, merely discloses that there are no standard mechanisms for protecting such information, and that the "use of encrypted data in special fields is the available nonstandard technique." Further, Cisco, at section 5.2.4, merely discloses that there is a legal requirement that the sender be disclosed on a facsimile message. Based on the disclosure of these sections, Cisco cannot reasonably be considered to teach, or to have suggested a communication control section for transferring the received electronic mail by facsimile over the telephone network only if the determination section determines that the transmission source is identified correctly.

Further, the Office Action broadly asserts that Windows 95 teaches a communication control section for transferring the received electronic mail by facsimile over the telephone network only if the determination section determines that the transmission source is identified correctly. This assertion relies on an improper construction of the Windows 95. Windows 95 discloses only the option of sending a digitally signed fax so that a recipient can verify that the purported sender of the fax is the actual sender (see, e.g., page 9). There is no teaching or suggestion of transferring the received electronic mail by facsimile over the telephone network only if the determination section determines that the transmission source is identified correctly. For at least these reasons, the rejection of claim 16 over Windows 95 is unreasonable.

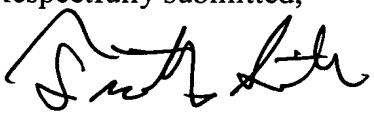
For the totality of the above discussion, neither Cisco nor Windows 95 can reasonably be considered to teach, or to have suggested, the combinations of all of the features positively

recited in independent claims 1, 6, 11 and 16. Additionally, claims 2-5, 7-10, 12-15 and 17 are also neither taught, nor would they have been suggested, by Cisco for at least the respective dependence of these claims directly on an allowable base claim, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, Applicants respectfully request that the Review Panel review the substance of the July 31, 2007 Final Rejection in light of the above remarks. Applicants believe that upon such review, the Review Panel will determine that the applied references do not teach, nor can they reasonably be considered to have suggested, the subject matter of the pending claims. In this regard, favorable reconsideration and prompt allowance of claims 1-17 are earnestly solicited.

Should the Review Panel believe that anything further would be desirable in order to place this application in an even better condition for allowance, the Review Panel is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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JAO:TSS/hms

Attachment:
Notice of Appeal and Petition for Extension of Time

Date: December 27, 2007

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